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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,389	04/30/2001	Gordon R. Nuttall	10003837-1	2738

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EXAMINER	
WORKU, NEGUSSIE	
ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/845,389

Applicant(s)

NUTTALL ET AL.

Examiner

Negussie Worku

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/27/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to the arguments***

1. This Office action is in response to amendment filed 11/27/06, Applicant's arguments with respect to claims 1, 13 and 19, has been carefully reviewed and found persuasive, and therefore, the prior arts used in the last office action under U.S.C. 103(a) has been withdrawn.

However, upon further consideration claims 1 through 21, are moot in view of the new ground(s) of rejection. Therefore, this Office action is non-final.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language:

3. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dourish (USP 6,950,982).

With respect to claim 1, Dourish teaches or discloses an image data capture device (a portable document reader of fig 1) for editing captured image data, col.2, lines 28-40) comprising: at least one image data capture element (mechanism 36 of fig 3, scans document 38, col.3, lines 38-40); an image data processor (electronic device 12, having a processing capability, which allow user to view a document 14 of fig 1, col.2, lines 65-67), for generating image files from image data acquired by said capture element, (a portable document reader of fig 1, which includes document scan r[activation mechanism] 36 of fig 3, scan and generates image for further annotation, annotation document [memo] 14 of fig of fig 1);

a user data entry device, (electronic device 12 of fig 1, which allows user to view document 14, and which includes same manner of input device 16 such as a mouse, stylus, electronic pen etc.), for enabling a user to modify said generated image files, col.2, lines 38-43), wherein said at least said one image data capture element, (mechanism 36 of fig 3, scans document 38, col.3, lines 38-40), said image data processor and said user data entry device are disposed within a portable container, (as shown in fig 1, electronic device 12, which includes a processing capability for scanned document 38 by scanner 36, for further processing [processing 43 of fig 5], and data entry device input device 16, such as [electronic pen, keyboard or stylus col.2, lines 40-43] are disposed within a portable document reader 12 of fig 1, col.2, lines 38-43).

With respect to claim 2, Dourish teaches or discloses an image data capture device (fig 1) wherein said image data capture element (annotation activation

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mechanism 36, scan document 38, see col.3, lines 38-40) is included in a digital camera, col.6, lines 3-2, and scanner 36 can be a CCD camera col.3, lines 38-40).

With respect to claim 3, Dourish teaches or discloses an image data capture device (fig 1) wherein said image data capture element (annotation activation mechanism 36, scan document 38, see col.3, lines 38-40) is included in a scanner, (scanner 36 of fig 3, col.3, lines 38-40).

With respect to claim 4, Dourish teaches or discloses the device (fig 1), wherein said user data entry device (electronic device 12 of fig 1, which allows user to view document 14, and which includes same manner of input device 16 such as a mouse, stylus, electronic pen etc.), comprises a pressure-sensitive tablet (as shown in 1, a display 10 having sensitive table, where annotation on document 14 is performed).

With respect to claim 5, Dourish discloses the device (fig), wherein said user data entry device (electronic device 12 of fig 1, which allows user to view document 14, and which includes same manner of input device 16 such as a mouse, stylus, electronic pen etc.), comprises an electro-magnetically coupled pen and writing surface (memo 14 is written by means input device [pen] on display 10 [a writing surface] as shown in fig 1).

With respect to claim 6, Dourish teaches or discloses the device (fig 1), wherein said user data entry device (16 of fig 1) comprises means for entering text annotation

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data into said generated image files (by input device 16, which can be a stylus or electronic pen, col.2, lines 39-43).

With respect to claim 7, Dourish teaches or discloses the device (fig 1), wherein said user data entry device (16 of fig 1, such as keyboard and pen as shown in fig 1) comprises means (stylus or electronic pen, 16 of fig1) for entering graphical annotation data into said generated image files, (col. 2, lines 51-55).

With respect to claim 8, Dourish discloses the device (fig 1), further comprising means (input means 16 of fig 1) for entering image file processing instructions to said device (electronic memo processing 12 of fig 1).

With respect to claim 9, Dourish discloses the device (electronic memo processing device 12 of fig 1), comprising means (image memo processing device of fig 1) for converting handwritten user entries employing said user data entry device (16 of fig 1) into machine recognizable, (col.2, lines 52-55).

With respect to claim 10, Dourish discloses the device (electronic memo processing of fig 1), wherein said user data entry device 16 of fig 1) enables superimposition of user data entry on a display of an image file of said generated image files, (electronic memo processing apparatus 12 of fig 1, having input device 16 of fig 1,

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such as keyboard, pen or mouse can be used as a user data entry device that gives instruction to a device, as shown in 12 of fig 1).

With respect to claim 11, Dourish discloses the device (electronic memo processing 12 of fig 1), wherein said user data entry device enables annotation of said generated image files by direction, (electronic memo processing apparatus 12 of fig 1, can be a keyboard or electronic pen are used as means entering image processing gives instruction to device shown in fig 1).

With respect to claim 12, Dourish discloses the device (electronic memo processing of fig 1), further comprising: a communication interface (user interface 62 of fig 6)) for coupling said device to a network, (WEB 82 of fig 6, col.col.5, lines 29-30, and col.6, lines 1-5)

With respect to claim 13, Dourish discloses a method for annotating information in an image capture device, (electronics memo processing device of fig 1) the method comprising the steps of: capturing image data within said image capture device, element (mechanism 36 of fig 3, scans document 38, col.3, lines 38-40); receiving user-entered data in connection with selected captured ones of said image data (input unit 16 of fig.1, col.5, lines 25-30); annotating said selected ones of said captured image data with said received user-entered data, see (col.5, lines 27-33); and performing said steps of capturing, receiving, and annotating within a portable assembly, (capturing the

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document or the image by scanner 36, and receiving the document into a processing system of fig 1, and annotating are performed with in a portable device 12 of fig 1, as shown in fig 1-5 and as discussed above).

With respect to claim 14, Dourish teaches or discloses the method (shown in fig 1) comprising the further step of: providing a network interface (interface 62 of fig 6, to a WEB 82 of fig 6) within said portable assembly (with in the electronic memo processing device of fig 1).

With respect to claim 15, Dourish teaches discloses the method (shown in fig 1-5), wherein said annotating step (step of fig 5), comprises the steps of: displaying a first image file of selected captured image data (display unit 10 fig 1, displaying a captured image data read by document reading unit 36 of fig 3, see steps 42-58 of fig 5); superimposing said user-entered data (as shown in fig 1, memo 14, annotation on document 14, on said displayed device 10 of fig 1, for updating); and providing a continuously updated display of said first image file as modified by said user-entered data, (by inputting means 16, user can update data on memo 14 of fig 1).

With respect to claim 16, Dourish teaches or discloses the method (shown in fig 1-5), further comprising the step of: electronically mailing said annotated selected ones of said at least one image files to at least one recipient, said recipient specified in said annotating step, see (col.6, lines 62-67)



With respect to claim 17, Dourish teaches or discloses the method (shown in fig 1), further comprising the step (see step 42-52 of fig 5) of: saving said annotated selected ones of said image data; see (col.12, lines 42-45).

With respect to claim 18, Dourish discloses the method (shown in fig 1), wherein said step of saving comprises the step of: transmitting said annotated selected ones of said image data over a public network to a node on said public network, (a communication interface 62 of fig 6, to WEB 82 of fig 6, col.5, lines 27-30).

With respect to claim 19, Kashiwagi et al. discloses the optical scanner (scanner 12 fig 1), comprising: means for capturing image data (scanner 36 of fig 3); means for displaying selected image data (display unit 10 of fig 1); means for receiving user-entered data in connection with said selected image data (electronic memo display unit 10, determine memo type 14 of fig 1); means for superimposing said received user-entered data on said displayed selected image data (selected image data graphic or text displayed on the memo display unit 10 for further editing or annotation on document 14 of fig 1, col.2, lines 5-55); and means (electronic memo processing device 12 of fig 1), for annotating said displayed selected image data with said superimposed received user-entered data, see (step 42-52 of fig 5).

With respect to claim 20, Dourish teaches or discloses the optical scanner (scanner 12 of fig 1), further comprising: a communication interface (user interface 62 of

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fig 6) for enabling said optical scanner (36 of fig 63) to communicate over a data communication network, (remote terminal or a server over a network, such as WEB 82 of fig 6) or under at least partial control of said means for annotating, see (col.6, lines 45-50).

With respect to claim 21, Dourish discloses the optical scanner ( fig 1) wherein the means for receiving comprises means for receiving handwritten graphical data (electronics memo processing 12 of fig 1, memo display unit 10 of fig 1) received handwritten graphic data, see (col.2, lines 51-54).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Negussie Worku whose telephone number is 571-272-7472. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on 571-272-7314. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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02/15/07

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